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Our Docket No.: 0325.00483

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Applicant: Pankaj K. Jha

Application No.: 09/881,367 Examiner: Patel, H.

Filed: June 14, 2001 Art Group: 2154

For: PROGRAMMABLE PROTOCOL PROCESSING ENGINE FOR
NETWORK PACKET DEVICES

CERTIFICATE OF MAILING

I hereby certify that this letter, the response or amendment attached hereto are being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 4, 2006.

By: Mary Donna Berkley
Mary Donna Berkley

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits the following Reply Brief pursuant to 37 C.F.R. §41.41 for consideration by the Board of Patent Appeals and Interferences. Appellant understands that the July 28, 2006 version of the Examiner's Answer completely replaces the June 6, 2006 version. As such, the arguments herein are directed to the July 28, 2006 version of the Examiner's Answer.

Docket Number: 0325.00483
Application No.: 09/881,367

STATUS OF CLAIMS

Claims 1-20 are pending and remain rejected. The Appellant hereby maintains the appeal for the rejections of claims 1-20.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The first issue is whether claims 1-8 and 10-17 are patentable under 35 U.S.C. §102(e) over Ogawa et al. (hereafter Ogawa), U.S. Patent No. 5,936,966.

The second issue is whether claim 9 is patentable under 35 U.S.C. §103(a) over Ogawa in view of Official Notice that processing a first parameter in accordance with a pointer to produce a second parameter in a non-programming step is well known in the art.

The third issue is whether claims 18-20 are patentable under 35 U.S.C. §103(a) over Ogawa in view of Wilford et al. (hereafter Wilford), U.S. Patent No. 6,687,247.

ARGUMENTS

RELATED APPEALS AND INTERFERENCES

Contrary to the Examiner's assertion¹, the Appeal Brief does contain an explicit statement on page 3 indicating that no related appeals or interferences are known to the Appellant, Appellant's legal representative, or Assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(4) STATUS OF AMENDMENTS AFTER FINAL

The Examiner's assertion that the Pre-Appeal Conference of October 20, 2005 "sustained the rejections of the claims 1-20"² is not supported by the record. The Pre-Appeal Conference (i) concerned less than half of the claims and (ii) only concluded that at least one actual issue is appropriate for appeal.³ As such, the Examiner's assertion regarding the Pre-Appeal Conference is merely a conclusory statement that is not supported by the record and thus cannot be sustained.

(8) GROUPING OF CLAIMS

Contrary to the Examiner's assertion⁴, the claims do not stand or fall together per 37 C.F.R. 1.192(c)(7). The rule 37 C.F.R. 1.192(c)(7) has been "reserved" since the introduction of the current

¹ Examiner's Answer, July 28, 2006, page 2.

² Examiner's Answer, July 28, 2006, page 3.

³ Notice of Panel Decision from Pre-Appeal Brief review, box 2 was checked.

⁴ Examiner's Answer, July 28, 2006, page 4.

appeals practice in 37 C.F.R. Part 41 on August 2004. The 37 C.F.R. Part 41 has no similar rule to 37 C.F.R. 1.192(c)(7). The authority cited by the Examiner has been obsolete for almost two years. As such, the Examiner's assertion that all of the claims stand and fall together cannot be sustained.

35 U.S.C. § 102 REJECTIONS

The Examiner's assertion that "several portions and several elements of the Ogawa are pertinent to and read upon the claimed subject matter"⁵ is not supported by the record. In particular, the Examiner has been unable to provide even a single example thread through Ogawa showing that the elements of Ogawa disclose "each and every element of the claimed invention, *arranged as in the claim*" as required by *Lindemann Maschinenfabrik GmbH*.⁶ Instead, the Examiner apparently performed a key-word text search of Ogawa during prosecution to identify any element that could even remotely be considered similar to individual claim elements, and in some cases, fragments of claim elements. The Examiner apparently then arranged the elements of Ogawa using the claims as a template instead of using the disclosure of Ogawa, which is improper hindsight. This key-word search/claim template approach was expanded in the Examiner's Answer and included new unsupported allegations of inherency (all respectfully traversed below). The Examiner's approach was so heavily dependent on the claims as a template that, in one example, a claim 1 limitation for "within an incoming packet" was rejected using one set of cites into Ogawa for the adjective "within

⁵ Examiner's Answer, July 28, 2006, page 14.

⁶ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added).

an incoming” and other cites into completely different sections of Ogawa for the noun “packet”.⁷ As a result, the Examiner’s arguments did not clearly identified which elements of Ogawa are allegedly similar to which claim elements making any further comparison of the claims with Ogawa difficult.

Furthermore, no assertion was made and no evidence was presented by the Examiner allegedly showing where Ogawa arranges the various cited elements as in the claims. If the claims are “so broad” and Ogawa is as good a reference as the Examiner believes, then it should have been easy for the Examiner to make a *prima facie* case for anticipation. Instead, the Examiner wrote page after page after page of cites to columns and paragraphs of Ogawa that failed to tie the elements of Ogawa together as in the claims. Showing that a single reference possibly discloses all of the claimed elements is only half the criteria per *Lindemann Maschinenfabrik GmbH* for establishing anticipation. The Examiner was required to show, but did not shown, the proper arrangement of the claim elements in Ogawa. Therefore, *prima facie* anticipation has not been established.

Furthermore, Appellant showed that the cited elements of Ogawa do not anticipate the claimed elements. In particular, Appellant showed that the cited elements of Ogawa *do not* fit the disclosure of Ogawa if forced into the arrangements of the claims. For example, in rejecting the claim 1 step for reading a pointer for a first parameter within an incoming packet, the Examiner apparently pointed to (i) a TCP protocol object pointer of Ogawa as allegedly similar to the claimed pointer and (ii) any element in a MAC header of Ogawa as similar to the claimed first parameter

⁷ Examiner’s Answer, July 28, 2006, page 16

within an incoming packet.⁸ Assuming, *arguendo*, that the Examiner's first assertion was correct and the TCP protocol object pointer of Ogawa is similar to the claimed pointer (for which Appellant's representative does not agree), Ogawa does not explicitly or inherently disclose that the TCP protocol object pointer is for at least one of the MAC header elements as presently claimed. For anticipation, *Scripps Clinic & Research Found.* requires that "[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention."⁹ However, a difference clearly exists between the first step of claim 1 and Ogawa. Otherwise, Ogawa would have (but did not) disclosed that the TCP protocol pointer is for one or more of the MAC header elements. Furthermore, Ogawa does not explicitly or inherently disclose any other element similar to the claimed pointer. Several additional examples were provided in the Appeal Brief where plugging the alleged similar elements of Ogawa in place of the claim elements produced results not disclosed by Ogawa. As such, Ogawa does not explicitly or inherently disclose each and every element as arranged in the claims.

Furthermore, the Examiner provided rejection arguments for elements not found in the claims. For example, the Examiner argued against the phrase "from a first network" in his arguments for claim 16.¹⁰ In contrast, the phrase "from a first network" is not part of claim 16. The phrase "from a first network" was actually created by the Examiner in the first Office Action.¹¹ In

⁸ Examiner's Answer, July 28, 2006, page 5.

⁹ *Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991).

¹⁰ Examiner's Answer, July 28, 2006, page 29.

¹¹ Office Action, August 27, 2004, page 5, paragraph 12.

another example, the Examiner discussed the phrase “a circuit structure within the data received device” in his arguments against claim 16.¹² In contrast, neither a “circuit structure” nor a “data receiving device” is in claim 16. The “data receiving device” is actually part of Ogawa, not the claimed invention. In still another example, the Examiner argued against the phrase “for a second network” in his arguments against claim 16.¹³ In contrast, the phrase “for a second network” is not part of claim 16. The phrase “for a second network” was actually created by the Examiner in the first Office Action.¹⁴ As such, the Examiner’s arguments against non-existing claim limitations cannot be sustained.

35 U.S.C. §103 REJECTIONS

The Examiner apparently maintained the alleged motivations for modifying/combining Ogawa with Official Notice or Wilford in the Examiner’s Answer. In contrast, Appellant previously showed in the Appeal Brief that the alleged motivations were merely conclusory statements not supported by the evidence of record. No new evidence or new alleged motivations were apparently provided in the Examiner’s Answer. Therefore, *prima facie* obviousness still has not been established for lack of a clear and particular showing of a teaching or motivation to combine/modify Ogawa as required by *In re Anita Dembiczak*. As such, *prima facie* obviousness has not been established and the rejections should be reversed.

¹² Examiner’s Answer, July 28, 2006, page 30.

¹³ Examiner’s Answer, July 28, 2006, page 32.

¹⁴ Office Action, August 27, 2004, page 5, paragraph 12.

Furthermore, the Examiner failed to establish a reasonable expectation of success for combining Ogawa and Wilford. Instead, the Examiner asserted that the reasonable expectations of success were “not relevant or necessary for combining the concerned teachings with the claimed invention.”¹⁵ While the Examiner is correct regarding no need to combine the teachings of Ogawa/Wilford *with the claimed invention*, M.P.E.P. §2142 still requires the Examiner to show that there is a reasonable expectation of success for the proposed combination/modification of Ogawa *with Wilford*, which has not been done. Therefore, *prima facie* obviousness has not been established for lack evidence for a reasonable expectation of success as required by M.P.E.P. §2142. As such, the rejections over Ogawa and Wilford should be reversed.

GENERAL

The Examiner repeatedly asserted that the Appellant discussed limitations in the Appeal Brief that were not found in the claims. For example, the Examiner asserted that “contrary to Appellant’s assertions limitations, ‘reading a pointer’ of the claim 1 is not limited to the pointer being part of the incoming packet.”¹⁶ In contrast, Appellant made no such assertion in the Appeal Brief. In another example, the Examiner asserted that “contrary to Appellant’s assertions, limitations, ‘framing’ is not limited to framing for a packet outgoing from the circuit or database.”¹⁷ In contrast, Appellant made no such assertion in the Appeal Brief. The Examiner wrote extensively in the Examiner’s Answer

¹⁵ Examiner’s Answer, July 28, 2006, pages 66-68.

¹⁶ Examiner’s Answer, July 28, 2006, page 24.

¹⁷ Examiner’s Answer, July 28, 2006, page 57-58.

arguing against alleged statements that were not made by the Appellant. As such, Appellant respectfully requests that the Board treat very carefully all assertions made by the Examiner paraphrasing what he thought the Appellant said and verify if the alleged statements were actually made or not.

Furthermore, Appellant's representative respectfully traverses all of the inherency arguments made in the Examiner's Answer. M.P.E.P. §2112 states:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy* 17 USPQ2d 1461, 1464, 1464 (Bd. Pat. App. & Inter. 1990)(emphasis in original)

However, no evidence, convincing line of reasoning or basis in fact was provided for any of the inherency assertions. The fact that the Examiner alleged that something is inherent does not mean that the inherency is true. For example, use of the TCP protocol and the IP protocol does not necessarily flow from the teachings of frame data, as alleged by the Examiner.¹⁸ Network protocols other than TCP and IP may be used for frame data as evidenced by Appendix A of the Appeal Brief. As such, all of the inherency assertions are merely conclusory statements and should be disregarded.

Regarding the objection of claim 18 discussed in the Examiner's Answer,¹⁹ M.P.E.P. §706.01 states:

Similarly, the Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board. These formal matters should not be combined in appeals to the Board.

¹⁸ Examiner's Answer, July 28, 2006, page 29.

¹⁹ Examiner's Answer, July 28, 2006, page 65.

As such, Appellant did not and will not discuss the objection during the appeal other than this brief quote of the M.P.E.P.

CONCLUSION

The Examiner's Answer contains incorrect statements regarding the Pre-Appeal Conference and the Appeal Brief. The Examiner's Answer cites obsolete appeals practice rules. Hence, the statements made by Examiner should be treated with caution as some are not supported by the record and rules.

The Examiner wrote extensively on word definitions, what limitations were not in the claims and what assertions were not made during prosecution. However, the Examiner failed to address where Ogawa allegedly discloses the elements as arranged in the claims, which is a necessary criteria to establish anticipation. Therefore, a *prima facie* case still has not been established for anticipation of claims 1-8 and 10-17 and the 35 U.S.C. §102 rejections should be withdrawn.

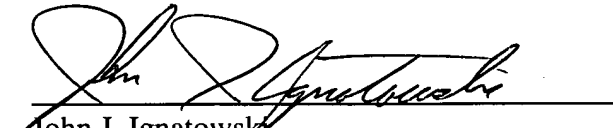
The Examiner alleged that the proposed motivations and alleged expectations for success were adequately presented in the record. In contrast, the Examiner merely presented conclusory statements, not evidence. Therefore, a *prima facie* case still has not been established for obviousness of claim 9 and 18-20 and the 35 U.S.C. §103 rejections should be withdrawn.

It is respectfully requested that the Board overturn the Examiner's rejection of all pending claims, and hold that the claims are not rendered obvious by the cited reference. However, should

the Board find the arguments herein in support of independent claims 1 and/or 16 unpersuasive, the Board is respectfully requested to carefully consider the arguments set forth above in support of each of the independently patentable groups.

Respectfully submitted,

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